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| 10/031,360 | 05/10/2002 | Koichi Komoda | 967 023 | 2576 |
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| MARJAMA & BILINSKI LLP 250 SOUTH CLINTON STREET SUITE 300 SYRACUSE, NY 13202 | | | EXAMINER HASAN, SYED Y | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/031,360

Applicant(s)

KOMODA, KOICHI

Examiner

Syed Y. Hasan

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6, 10, 13, 21-23, 26, 29, 42 and 82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6, 10, 13, 21-23, 26, 29, 42 and 82 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :07/09/2002, 06/07/2004, 06/10/2004, 09/13/2004, 04/08/2005.

DETAILED ACTION

Response to Restriction/Election

1. Applicant's election, without traverse, of species 4 corresponding to Figure 6 and 7 and Claims 6, 10, 13, 18, 21 – 23, 26, 29, 42 and 82 is acknowledged.

Claim Objections

2. Claims 21, 22, 23, 26, 29 and 42 are objected to because of the following informalities:

(1) Claim 21 mentions "defined in claim 6 or 7". Since claim 7 has been cancelled, examiner has taken the initiative to respond to "defined in claim 6" only.

(2) Claim 22 mentions "defined in claim 13 or 14". Since claim 14 has been cancelled examiner has taken the initiative to respond to "defined in claim 13" only.

(3) Claim 23 mentions "defined in claim 18 or 19". Since claim 19 has been cancelled, examiner has taken the initiative to respond to "defined in claim 18" only.

(4) Claim 26 mentions "defined in any of claims 10, 11, 13 and 14". Since claims 11 and 14 have been cancelled, examiner has taken the initiative to respond to "defined in any of claims 10 and 13" only.

(5) Claim 29 mentions "defined in any of claims 10, 11, 13 and 14". Since claims 11 and 14 have been cancelled, examiner has taken the initiative to respond to "defined in any of claims 10 and 13" only.

(6) Claim 42 mentions "defined in any of claims 10, 11, 13 and 14". Since claims 11 and 14 have been cancelled, examiner has taken the initiative to respond to "defined in any of claims 10 and 13" only.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6, 10, 13, 18, 21, 22, 23, 26, 29, 42 and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogino (US 6433946) in view of Yamamoto et al (US 6904227) and further in view of Hirai (US 6839503)

Regarding claim 6 Ogino discloses a playback/recording apparatus for performing transfer of contents recorded on an erasable storage medium, between apparatuses:

said playback/recording apparatus comprising a playback apparatus as a first apparatus (fig 1, 110, col 2, line 22, playback device 110) a recording apparatus as a second apparatus (fig 1, 120, col 2, line 23, recording device 120) and a transmission line such as a transmission cable or the like for connecting the first and second apparatuses (fig 1, 101, col 2, line 24, transmission line 101)

said first apparatus comprising:

a first authentication means for performing mutual authentication (fig 2, 15, 16, col 7, lines 26 - 28, anti-duplication control signal detection section 15 and copy guard signal detection section 16) and transfer of contents between itself and the

second apparatus (col 2, lines 46 – 53, recording is performed)

a playback means for reproducing contents recorded on a first storage medium (fig 2, 11, col 7, line 24, read out section 11) and outputting the reproduced contents (fig 2, 14, col 7, line 25, output control section 14)

a detection means for detecting copyright information of the contents (fig 2, 15,16, col 7, lines 26 - 28, anti-duplication control signal detection section 15 and copy guard signal detection section 16)

a recording means for recording the contents on a second storage means (fig 1, 121, col 2, line 50, recording section 121)

Ogino, however does not disclose an erasing means for erasing the contents from the first storage medium

Yamamoto et al, on the other hand, teaches an erasing means for erasing the contents from the first storage medium (col 2 lines 31 – 33)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate an erasing means for erasing the contents from the first storage medium as taught by Yamamoto et al in the system of Ogino in order to prevent further copying of the recorded content.

The combined system of Ogino and Yamamoto et al, however does not disclose an encryption means for encrypting the output from the playback means, and outputting the encrypted data, and a second apparatus comprising:

a second authentication means for performing mutual authentication and transfer of contents between itself and the first apparatus and a decryption means for

decrypting the encrypted data

Hirai, on the other hand, teaches an encryption means for encrypting the output from the playback means, and outputting the encrypted data (col 5, lines 9 – 21, encryption) and a second apparatus comprising:

a second authentication means for performing mutual authentication and transfer of contents between itself and the first apparatus (col 5, lines 9 – 21, authentication) and

a decryption means for decrypting the encrypted data (col 5, lines 9 – 21, decryption)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the encryption and decryption method and the authentication for the second apparatus as taught by Yamamoto et al in the system of Ogino in order to prevent further copying of the recorded content.

wherein, when performing transfer of the contents, mutual authentication is carried out between the first authentication means and the second authentication means, the contents are reproduced by the playback means and outputted and, when the output of the detection means indicates that the contents are copy-inhibited, data of the contents are encrypted by the encryption means and outputted, the contents are erased from the first storage medium by the erasing means, the encrypted data are decrypted by the decryption means and outputted, and the contents are recorded on the second storage means by the recording means, thereby transferring the contents.
(rejected based on the information contained above)

Claims 10, 13 and 18 are rejected based on claim 6 above

Regarding claim 21 Ogino does not disclose the playback/recording apparatus defined further comprising a temporary storage means for temporarily storing the contents; wherein the contents are temporarily stored in the temporary storage means.

Hirai, on the other hand, teaches the playback/recording apparatus defined further comprising a temporary storage means for temporarily storing the contents; wherein the contents are temporarily stored in the temporary storage means. (col 14, lines 49 – 51, temporary storage)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the playback/recording apparatus defined further comprising a temporary storage means for temporarily storing the contents; wherein the contents are temporarily stored in the temporary storage means as taught by Hirai in the system of Ogino in order to provide a temporary location for the contents.

Claims 22 and 23 are rejected based on claim 21 above

Regarding claim 26/10 Ogino discloses the playback/erasing apparatus as the first apparatus defined in any of claims 10, 11, 13, and 14, further comprising a first control means for controlling the playback means; wherein the playback means are controlled by the first control means, thereby performing transfer of the contents. (abstract, the output control signal generation section controls the output control section so as not to output the playback video signal S4.)

However, Ogino does not disclose, controlling the erasing means;

Yamamoto et al, on the other hand, teaches controlling the erasing means (col 2

lines 31 – 33)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate controlling the erasing means as taught by Yamamoto et al in the system of Ogino in order to prevent further copying of the recorded content.

Claims 26/13, 29/10, 29/13, 42/10, 42/13 and 82 are rejected based on claim 26/10 above

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

Kawamae et al (US 6578149) discloses a method for producing data, apparatus for reproducing data, method for coding data, method for recording data.

Kori et al (US 6480607) discloses an encrypted reproducing transmitting and processing method and apparatus with separately encrypted control data.

Ogino (US 6427047) discloses an apparatus and method for detecting the unauthorized duplication of a signal.

Kori et al (US 5778064) discloses an apparatus and method for processing a high definition video signal.

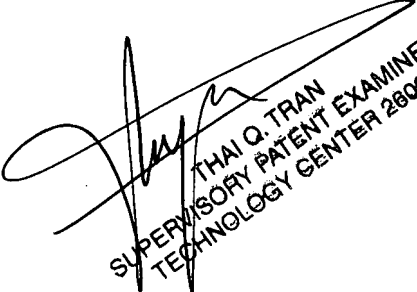
Kim et al (US 5799081) discloses an illegal view/copy protection method and apparatus for digital broadcasting system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Y. Hasan whose telephone number is 571-270-1082. The examiner can normally be reached on 9/8/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.Y.H.
5/11/2007


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